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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Stehle USA, Inc.

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Serial No. 75/873,272

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Edward P. Kelly, Kirkpatrick & Lockhart LLP for Stehle USA, Inc.

John T. Lincoski, Jr., Trademark Examining Attorney, Law Office 104 (Sidney Moskowitz, Managing Attorney).

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Before Simms, Walters and Bottorff, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Stehle USA, Inc. (applicant), a North Carolina corporation, has appealed from the final refusal of the Trademark Examining Attorney to register the mark shown below:



for "woodworking tools namely power, circular saw blades, milling cutters and tongue and groove cutters, jointing cutters for stationary shaping machines; molder tools for use on industrial molder machines; power driven planer heads, insert knives for industrial planning machines; power drill bits, bushes and spacers router bits; all for use as accessories attached to power-operated woodworking machines" in Class 7.<sup>1</sup> The Examining Attorney has refused registration under Section 2(d) of the Act, 15 USC §1052(d), on the basis of two registrations of the mark STIHL (one slightly stylized) for the following goods:

electric motors; saws, internal combustion engines, portable brush cutters and cutters for tree surgery driven by two-cycle internal combustion engines, tree bark removing devices, free cutting saws, separating grinding devices, earth drilling devices, and tractors;<sup>2</sup>

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<sup>1</sup>Application Serial No. 75/873,272, filed December 16, 1999, based upon an allegation of use in commerce since January 1979. Applicant has disclaimed the representation of the saw blade in the drawing of the mark.

<sup>2</sup>Registration No. 855,458, issued August 27, 1968, renewed.

motor saws and parts thereof; saw chains and guide bars; maintenance tools for motor chain saws and for saw chains; abrasive and cutting-off machines and grinding wheels; power-operated weed, grass and brush cutters and cutting tools thereof; power-operated hedge clippers; power-operated blowers and pesticide sprayers; earth boring machines and drills thereof; machine sharpeners for saw chains, tree harvesting machines; and wedges for use in tree cutting sold as a unit with motor saws, guide bar scabbards for motor saws, and carrying cases for motor saws.<sup>3</sup>

Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

We affirm.

It is the Examining Attorney's position that the most prominently displayed and the most dominant element of applicant's mark is the word portion STEHLE, which is similar in sound and appearance to registrant's mark STIHL. The Examining Attorney argues that these marks could be pronounced the same and, even if they are pronounced differently, that slight differences in pronunciation are not sufficient to avoid the likelihood of confusion. Also, the slight differences in spelling of these marks is insufficient to avoid confusion, according to the Examining

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<sup>3</sup>Registration No. 1,244,156, issued July 5, 1983, Sections 8 and 15 filed. This registration issued under the provisions of Section 2(f) of the Act, 15 USC §1052(f).

Attorney. In this regard, the Examining Attorney argues that the average consumer's memory is not infallible.

With respect to the goods, the Examining Attorney argues that some of the goods are highly related--power tools for cutting and sawing lumber and wood. Because there is no limitation in the descriptions of goods in either the registrations or the application, we must presume that the descriptions encompass all goods of the type described and move in all normal channels of trade for these goods. Accordingly, there is no limitation with respect to the industry in which the goods are sold or the intended purchasers, the Examining Attorney contends. Furthermore, the Examining Attorney points to the third-party registrations made of record which show goods similar to those of applicant and registrant being sold by the same entity (for example, woodworking machines and chain saws). Finally, the Examining Attorney asks us to resolve any doubt in favor of the registrant.

Applicant, on the other hand, maintains that its mark consists of a highly stylized composite mark in which the circular saw design element is dominant. It is the applicant's position that its mark is pronounced "Stay-ley" as opposed to the cited mark, which is pronounced like the

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word "Still." Applicant argues, therefore, that the marks have separate and distinct commercial impressions.

Concerning the goods, applicant contends that its tools are accessories attached to power-operated woodworking machines in the woodworking industry and used by hobbyists who restore wood furniture and by cabinet and furniture manufacturers, whereas registrant's different goods are industrial saws used in the lumber industry. However, in its reply brief, applicant states that registrant's goods may be used by consumers or in the construction industry. Because applicant does not sell to the lumber industry, applicant maintains that the goods are sold in different channels of distribution.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Upon careful consideration of this record and the arguments of the attorneys, we conclude that applicant's

mark used in connection with woodworking tools so resembles the registered marks used in connection with electric and motorized saws, saw chains and other tools that confusion is likely.

First, concerning the marks, it is well settled that it is improper to dissect a mark. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). However, more or less weight may be given to a particular feature of a mark for rational reasons. *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)("[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entirety.") We cannot agree with applicant that the design element (which it has disclaimed) is the most dominant part of the applicant's mark. Rather, the word STEHLE predominates and would be the portion of the mark used by consumers in asking for applicant's goods. While this dominant part of applicant's mark is not identical to registrant's mark STIHL, both marks begin with the letters "ST" and contain the consonants "HL." Furthermore, while we cannot be sure how the respective marks may be pronounced, we believe that a substantial number of

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purchasers are likely to pronounce these designations in a similar, if not identical, manner.

With respect to the goods, we note that goods need not be identical or even competitive in order to support a holding of likelihood of confusion. Rather, it is sufficient that the goods are so related or that the conditions surrounding their marketing are such that they are encountered by the same persons who would mistakenly believe that the goods originate from the same producer because of the close relationship between the goods and the similarities of the marks. See *Hercules Inc. v. National Starch and Chemical Corp.*, 223 USPQ 1244, 1247 (TTAB 1984). Here, the Examining Attorney has submitted some evidence which tends to establish a relationship between the goods involved here. The third-party registrations show the same mark registered by the same entity for some of the goods of applicant and registrant. Although these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nevertheless have probative value to the extent that they serve to suggest that the goods listed therein, including woodworking machines and chain saws, are of a kind which may emanate from a single source. See, e.g., *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993);

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and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 at n. 6 (TTAB 1988). Moreover, because there is no limitation with respect to the channels of trade or potential purchasers in the identifications of applicant and registrant, we must presume that these goods travel in all normal channels of trade to all potential purchasers thereof. Accordingly, we believe that purchasers of registrant's STIHL motorized saws, cutting saws, saw chains and other tools who then encounter applicant's STEHLE and design saw blades and other woodworking tools are likely to believe that all of these goods come from the same source. This is all the more likely because purchasers may not recall the precise spelling of registrant's mark. In view of the fallibility of memory, purchasers may retain only a general, rather than a specific, impression of registrant's trademark. Finally, if we had any doubt about the issue, that doubt, in accordance with well-established precedent, must be resolved in favor of the registrant.

Decision: The refusal of registration is affirmed.